



**THE STATE BAR
OF CALIFORNIA**

COMMITTEE ON PROFESSIONAL
RESPONSIBILITY AND CONDUCT

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TELEPHONE: (415) 538-2161

June 10, 2004

Mr. Harry I. Moatz
Director, Office of Enrollment and Discipline
Mail Stop OED-Ethics Rules
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Comments on Proposed Rules (37 C.F.R., Part 11)

Dear Mr. Moatz:

The State Bar of California Standing Committee on Professional Responsibility and Conduct appreciates the opportunity to comment on the proposed changes to the PTO rules regarding representation of others before the PTO. We commend the PTO's effort to modernize its rules and to conform them to the rules in the various states. We write principally to comment on the procedure the PTO has employed and to suggest that a broader process, permitting more input from, and consultation with, practicing attorneys would benefit the PTO in formulating the final set of rules.

At the outset, we note that the PTO's proposal is daunting in size and detail, particularly in light of the PTO's decision to change significantly the older set of ABA rules that the PTO used as its starting point. We have reviewed the comment letter submitted by the State Bar of California Intellectual Property Section Commission as well as the comment filed by the American Intellectual Property Law Association ("AIPLA"). While time limitations prevented us from studying those comments in sufficient detail to enable us to provide you with a detailed comment on each of the points they raised, we have had sufficient time to appreciate the serious concerns the comments have identified. We believe both sets of comments warrant serious consideration.

In particular, we second AIPLA's suggestion that the PTO publish its next draft of the proposed rule for further public comment. We also propose that the PTO go a step further and appoint an advisory commission of practicing patent practitioners and ethics experts to help the PTO assess the comments received and evaluate the best course for the PTO to take in amending its rules of professional conduct. The ABA followed an open and inclusive approach in its Ethics 2000 process, in which the ABA extensively revised its Model Rules, and the California Commission for the Revision of the Rules of Professional Conduct is likewise conducting an open and transparent

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process as the Commission works on a comprehensive revision of the California Rules of Professional Conduct. We urge the PTO to follow these examples and create a review structure that would permit the kind of dedicated give-and-take with those affected by these rules that was emblematic of the Ethics 2000 process. The end result will be a superior product.

These comments are from the State Bar of California Standing Committee on Professional Responsibility and Conduct. They do not constitute the position of the State Bar of California or its Board of Governors. The Board of Governors is free to submit its own comment on behalf of the State Bar of California.

Very truly yours,

Dominique M. Snyder, Vice-Chair
The State Bar of California
Committee on Professional
Responsibility and Conduct